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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,079	10/21/2005	Martin Kurth	16-885 P/US	4484
26294 7590 09/10/2008 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
MAIL DATE		DELIVERY MODE		
09/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,079

Applicant(s)

KURTH ET AL.

Examiner

VICTOR MACARTHUR

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/2008 has been entered.

Drawings

The drawings were received on 12/4/2008. These drawings are **NOT** acceptable since they contain new matter as follows:

- The cross-sectional shape of (2, 3, 4) as seen in fig.5 was not previously presented.
- The precise engagement of 30 with 2 and 3; and lack of engagement with 4.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “base” (line 2 of claim 7), “at least one engagement element [of the inner sleeve]” (lines 11-12 of claim 7); the “at least one engagement element on the outer sleeve” (lines 12-13 of claim 7); and the plurality of engagement elements (two separate recitations in lines 2-4 of claim 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in the claims must be described in the written description with reference characters regarding the drawings; or those features must be deleted from the claims. Take for example the following examples:

- The specification as amended in the filing of 6/24/2008 refers repeatedly to a base part 30 in figure 5, which is not present in the originally filed drawings. Drawings of 6/24/2008 contain new matter (as detailed above) and are thus unacceptable and

therefore cannot be relied upon for antecedent basis for the written description and claims.

Claim Objections

The claims are objected to because of the following informalities:

- The claimed elements noted in the objection to the drawings above are not **properly** recited in the specification (see specification objection above). Furthermore, it is unclear which drawing elements, if any, are represented by the above-mentioned phrases.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 8, 12-14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamman (U.S. Patent 4,304,148).

Claims 7 and 17. Hamman discloses (fig.3) a device for fastening cable comprising: a base having a carrier part (82) for holding the cable; a first connecting unit comprising a sleeve (70) connected to the carrier part; and a second connecting unit comprising a guide part (20) connected to the carrier part and a holding part (60) releasably engageable with the guide part;

wherein the guide part includes an outer sleeve (20) that defines a guide cavity (cavity within 20) for receiving the holding part, the guide cavity having a cross section that is longer in the longitudinal direction than in the transverse direction, the longitudinal direction and the transverse direction being orthogonal to one another; wherein the holding part includes an inner sleeve (60) having a smaller diameter than the diameter of the outer sleeve, the inner sleeve being inserted into the outer sleeve along the transverse direction of the outer sleeve, the inner sleeve including at least one engagement element (groove receiving 32) that engages at least one engagement element (32) on the outer sleeve to fasten the cable to the carrier part; wherein the inner sleeve is displaceable relative to the outer sleeve in the longitudinal direction when the inner sleeve is engaged with the outer sleeve.

Claim 8. Hamman suggests the device of claim 7 wherein the at least one engagement element on the inner sleeve comprises a plurality of engagement elements and the at least one engagement element on the outer sleeve comprises a plurality of engagement elements.

Claim 12. Hamman suggests the device of claim 7 wherein the holding part surrounds a continuous holding channel (holding channel within 60) and is configured with inward pointing latching lugs (lugs latching onto 32).

Claim 13. Hamman suggests the device of claim 7 wherein the first connecting unit further comprises a displaceable holding part (90) releasably engageable with the sleeve, whereby the longitudinal direction of the holding part of the first connecting unit is parallel to the longitudinal direction of the holding part of the second connecting unit (in that they are coaxial).

Claim 14. Hamman suggests the device of claim 7. In accordance with MPEP 2112.01 it is presumed that the prior art structure is inherently capable of performing the functional

limitation "wherein the holding part and guide part cooperate to adapt to positional and dimensional errors in the second connecting unit". Regarding inherency of functional limitations, see MPEP 2112.01 (I). See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Claim 16. The device of claim 7, wherein the carrier part comprises an elongated cable channel (channel in 82 receiving 72) for receiving the cable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamman (U.S. Patent 4,304,148).

Claim 9. Hamman suggests the device of claim 8, wherein the engagement elements on the outer sleeve are formed by guide projections (32) that extend in the longitudinal direction and the engagement elements on the inner sleeve are formed by guide recesses (recesses receiving 32) that extend in the longitudinal direction. Furthermore:

- The reversal of components in a prior art reference is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).
- The applicant has failed to demonstrate criticality by any showing of unexpected result derived from projection and recess orientation. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to reverse the position of the prior art projections and recesses, since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).
- Such modification would necessarily result in the engagement elements on the outer sleeve being formed by guide recesses that extend in the longitudinal direction and the engagement elements on the inner sleeve are formed by guide projections that extend in the longitudinal direction.

Claim 10. Hamman suggests the device of claim 9 wherein the guide projections are configured on walls of the guide part and the guide recesses are configured on walls of the holding part.

Claim 11. Hamman suggests the device of claim 10 wherein the guide projections exhibit a substantially triangular cross section, whereby the leading edge of the projection is more steeply angled than the trailing edge of the projection during engagement with the inner sleeve.

Claim 15. The device of claim 7, wherein the carrier part has an open end (end of 82 receiving 90) and a closed end (top end of 82) for receiving the cable, the base covering the closed end to hold the cable. Hamman discloses that the carrier part (82 is a work piece such as a brake drum or automotive firewall. The examiner takes OFFICIAL NOTICE that such workpieces are well known to comprise U-Shaped profiles for the purpose of increasing strength over flat profiles. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Hamman work piece to comprise a U-shaped profile for the purpose of increasing strength.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

September 9, 2008

/Victor MacArthur/
Examiner, Art Unit 3679